



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA VA 22182-3817

MAILED

MAY 12 2005

**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600**

In re Application of:
Takao Inoue
Application Serial No.: 10/060,398
Filed: February 1, 2002
For: **LIGHT EMITTING DIODE DRIVING
CIRCUIT**

**DECISION
ON PETITION**

This is a decision on the petition under 37 CFR 1.181 filed April 8, 2005 to request a refund of fees paid for entry of an examiner's amendment.

The Petition is **Denied**.

Petitioner asserts that the charge for the extension of time fee to perform an examiner's amendment was not appropriate given the section set forth in MPEP §706.07(f). Specifically, petitioner states that the Examiner's requirement that dependent claims be incorporated into the independent claim was a mere formal matter that was not previously of record and could have easily have been executed by Applicant in response to an Ex parte Quayle action with no extensions of time fees required. Petitioner continues by arguing that "...if an Examiner does not wish to execute an Examiner's Amendment, it is submitted that the appropriate procedure clearly identified in MPEP §706.07(f) (N) is that the Examiner instead prepares an Ex parte Quayle action so that Applicant himself can then make the formal corrections."

MPEP §706.07(f) [R-2] Time for Reply to Final Rejection, states in part:

(N) Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an Ex parte Quayle action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters — the correction of which had not yet been required by the examiner.

A review of the file history reveals that a final Office action was mailed on November 18, 2004. On February 14, 2005, applicant filed an amendment after final which appears to have been entered. On February 24, 2005 the record indicates that an interview was held wherein the examiner set forth the position that independent claim 6 was too broad and that an Advisory action would be mailed. During a follow-up interview apparently held on March 23 and 24, 2005, the examiner indicated that the application would be in condition for allowance if dependent claims 8 and 9 were included within the independent claim. The examiner was authorized to perform the examiner's amendment. The examiner insisted that extension of time fees were required in order to perform an examiner's amendment. Applicant reluctantly agreed to payment of the extensions of time in order to advance the application to issue.

Within the subject petition, petitioner argues that if the examiner did not want to do an examiner's amendment, then the examiner should have set forth a Quayle action so that the applicant could have performed the necessary amendment without having to pay for extensions of time.

MPEP §714.14 Amendments After Allowance of All Claims, states in part:
Under the decision in Ex parte Quayle, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm'r Pat. 1935), after all claims in an application have been allowed the prosecution of the application on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution. [emphasis added]

As the file record reveals, the examiner did not consider independent claim 6 to be in condition for allowance, which was why it was necessary to incorporate dependent claims 8 and 9 into independent claim 6, i.e., in order to place the application in condition for allowance. According to MPEP §714.14 set forth above, Quayle actions are permitted only after all claims are allowed. A prosecution closing action, i.e., an Ex parte Quayle action, may be issued in order to correct any outstanding formal objections. As indicated, independent claim 6 was not in condition for allowance and therefore issuance of an Ex parte Quayle action would have been improper. Therefore, petitioner's argument that the examiner could have just issued a Quayle action for applicant to perform an amendment without having to pay for extensions of time, is untenable.

Regarding petitioner's argument that incorporation of dependent claims into independent form is merely a formal matter, the basis for this contention was gathered from MPEP §706.07(f). Specifically, the section relied upon for support begins by stating: (N) Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an Ex parte Quayle action if the application is otherwise in condition for allowance.

However, as previously noted in MPEP §714.14 above, in order to qualify for an Ex parte Quayle action, all of the claims in the application must be in condition for allowance. There is an obvious distinction then between consideration of claims on their merit in an application versus formal matters and/or objections.

37 C.F.R. § 1.111 Reply by applicant or patent owner to a non-final Office action, states in part:...

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements

as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. [emphasis added]

MPEP §714.02 [R-2] Must Be Fully Responsive, states in part:...

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters>, although the filing of drawing corrections in reply to an objection to the drawings cannot normally be held in abeyance<. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter. [emphasis added]


As evidenced by 37 C.F.R. §1.111 and MPEP §714.02 above, objections and requirements of form, e.g., drawing or specification corrections, etc. are considered to be formal matter issues not requiring further action and/or consideration of the claims. The incorporation of subject matter from a dependent claim into an independent claim requires further consideration on the merits, with respect to the scope of coverage sought and is not a matter of form. The resultant claim would require further consideration by the examiner, e.g., to insure that the newly written claim continued to comply with 35 U.S.C. §112. Therefore, Petitioner's contention that MPEP §706.07(f) (N) provides support for the position that applicants do not have to pay for extensions of time in order for an examiner to perform an examiner's amendment, is also untenable.

Given that the proposed amendment was not merely a matter of form, then in accordance with MPEP §706.07(f), subpart (I), if the time period for response to the outstanding final Office action was outside of the 3 month shortened statutory period for response, applicants were required to pay for the appropriate extensions of time in order for the examiner to perform an examiner's amendment.

MPEP §706.07(f) [R-2] Time for Reply to Final Rejection, states in part:

(I) Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a). [emphasis added]

The application file having been allowed, will be forwarded to Office of Publications to process into a Patent in appropriate turn.



Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications